REMARKS

This is in response to the Office Action mailed on <u>August 26, 2004</u>, and the references cited therewith.

Claims <u>1, 8, and 15</u> are amended; as a result, claims <u>1-20</u> are now pending in this application.

§101 Rejection of the Claims

Claims 1-20 were rejected under 35 USC § 101 as being directed to non-statutory subject matter.

It has long been established that an invention implemented in software is acceptable statutory subject matter. Moreover, Applicant respectfully asserts that the Examiner is under an affirmative obligation to specifically and unambiguously provide the Applicant with instructions to correct defects associated with non statutory subject matter. Applicant assumes that the Examiner has requested that the preamble to the claims specifically state that they were "implemented in a computer readable medium." This has been done with the amendments above. Therefore, Applicant believes that these rejections have been overcome, since the claims are now "implemented in a computer readable medium." Thus, the rejections should be withdrawn.

Applicant would also like to note that there is no requirement that computer readable medium be recited in the body of a claim. Applicant believes the Examiner is grossly misinterpreting the law and MPEP, if this is in fact the case, and Applicant respectfully requests the Examiner point the Applicant to a single requirement that states a claim body must recite computer readable medium, if the Examiner believes this to be the case. Applicant respectfully asserts that this is not and never has been a requirement in the law of claim interpretation with respect to software claims. Moreover, the Applicant respectfully asserts that Applicant cannot be expected to guess at what the Examiner wants with respect to correcting the perceived defect with respect to section 101. The Examiner is under an affirmative obligation to specifically instruct the Applicant on how the Examiner believes that these defects can be corrected.

If the Examiner believes that the amendments do not correct the perceived defects then the Examiner should not issue a Final in response hereto because Applicant has not been

provided enough guidance on this from the Examiner. This is so, because clearly software is and long has been acceptable subject matter and the Applicant has now recited in the amended claims that the invention is "implemented in a computer readable medium." Additionally, there is no requirement that this limitation be recited in the body of the claims.

Applicant respectfully requests that the Examiner contact Applicant's representative at the below listed number so that the Examiner and the Applicant's representative can engage in an interactive dialogue to determine what it is that the Examiner is looking for with respect to these claims and their perceived deficiencies, if Applicant's changes are not what the Examiner was looking for.

Applicant assumes that the tangible result rejection is based on the Examiner's determination that the invention was divorced from any tangible medium, namely from being "implemented in a computer readable medium." This has now been corrected and therefore Applicant believes that this rejection is no longer appropriate since the mere transformation of data has been considered a sufficient result with respect to software and data structure claims.

Moreover, it is clear from the language of each independent claim that correlations are determined and those correlations define selecting contacts of a campaign or determining an order of contacts for a campaign. This language, on its face, is a tangible result with utility, since contacts are selected based on determined correlations, contacts are sorted based on determined correlations, and contacts are reordered based on determined correlations (claims 1, 8, and 15). This is clearly useful in the CRM arts where campaigns for goods and services are regularly deployed and where the ability to determine correlations and to more correctly select contacts, which may be more receptive to the campaigns, are of vital importance to the efficiency and success of the campaigns. Therefore, it cannot be said that the claims lack a tangible result. Moreover, it has been long established that an asserted utility creates a presumption of utility.

Applicant would also like to note that the 101 rejections did not re-appear in the Final Office Action levied by the Examiner having a mail date of February 20, 2004. In that Final Office Action only the 103 rejections were levied, the previous 101 rejections were withdrawn and not maintained in that Final. Applicant is confused as to how the 101 rejections were previously overcome but are now being resurfaced by the Examiner. This does not make sense to the Applicant and provides yet another reason why it would be inappropriate for the Examiner

to issue a Final in response hereto, if the Examiner intends to continue to maintain the 101 rejections because Applicant believed these had been cleared up in prior responses, since they did not resurface with the Final dated February 20, 2004. This provides further evidence that the Examiner has not adequately communicated how and what the Applicant is expected to correct.

Furthermore, if the rejections cited under section 101 are related to the rejections below with respect to the section 112 rejections, then the arguments presented below are incorporated by reference herein.

For all these reasons the 101 rejections are not appropriate and should be withdrawn.

§112 Rejection of the Claims

Claims 1-20 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation.

The burden of establishing a prima facie showing for enablement is on the Examiner. MPEP, Sec. 2164.04. The prima facie showing *must* also present sufficient detail to the Applicant in the first Office Action that would permit the Applicant a chance to correct the defects prior to the Examiner's issuance of a Final Rejection. Moreover, it is not sufficient to conclusively state lack of enablement; the Examiner *must* clearly state why "detailed information to specifically describe an environmental change, or a current event" would be needed by one of ordinary skill in the art. The Examiner has not provided this detail. The Examiner has simply stated it is needed but not indicated why it is needed. Thus, Applicant respectfully asserts that the Examiner has not met the burden of a prima facie showing under MPEP Sec. 2164.04. These points are emphasized and stressed in the MPEP Sec. 2164.04.

Moreover, in considering enablement issues, all factors are to be considered based on the evidence as a whole. An enablement issue cannot be based on a single factor or based on a single factual observation and a conclusion drawn by the Examiner based on a single factor. MPEP, Sec. 2164.01 (a). Here, the Examiner has conclusively stated that because an environmental change and a current event are not described in *specific* detail, the support for these terms is not enabled in the specification. The Examiner has not described why *specific* detail is needed.

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One art area associated with correlations as used in the independent claims is statistics. The analysis needs to be taken in view of a statistician and what a statistician of ordinary skill in the art would understand or not understand based on the complete record, the claims, the figures, and the specification. Statisticians regularly employ correlations and populations in statistical studies. Correlations and populations are common and well understood concepts and are regularly deployed in a variety of manners and fields including the programming arts.

The claims state that at configurable contact intervals a correlation is noted between completed contacts and demographic attributes. The contact intervals represent elapsed periods of time associated with environmental changes occurring outside the scope of the campaign and the environmental changes effect the correlation during the elapsed period of time and the environmental changes are related to current events occurring during the campaign.

An example of a current event was provided in the specification and may be found at page 19 in the first full paragraph where it is stated that a campaign is being conducted during the Super Bowl (current event). As the campaign progresses, the Super Bowl ends (another current event) the campaign detects that now men are more receptive to a sales pitch of the campaign; as a result, an external environmental change associated with a current event (Super Bowl) effects the correlation, which now reflects the fact that more men are being reached and are receptive to the sales pitch of the campaign.

After reading this description in the original specification and reading the claim language, a statistician would not need more information to understand what is meant by an environmental change or a current event. The point is that because the campaign progresses at intervals and constantly readjusts itself based on feedback that it is getting by way of responses to the campaign's sales pitch that correlations will surface which are related to events (current events or environmental changes) because of the intervals and their progression in time. Applicant respectfully disagrees that this is not clear enough for a statistician. The statistician does not even need to know what the environmental change is or know what the exact current event is; but its existence, if significant enough, will alter the correlation and affect the contacts being used within the campaign as the campaign progresses. This is intuitive to a statistician and needs no further explanation other than what has been already provided in the specification.

Additionally, it has been repeatedly asserted by the courts: "that which is known to one skilled in the art need not be disclosed and in fact is often best omitted." *In re Wands*, 858 F.2d 731, at 737 (Fed. Cir. 1988); MPEP, Sec. 2164.08. Furthermore, how a teaching is set forth by specific example or broad terminology is not important. *In re Marzocchi*, 439 F.2d 220, at 223-224; MPEP, Sec. 2164.08. Additionally, the evidence or arguments provided by an Applicant in support of enablement need not be conclusive, but rather "merely convincing to one skilled in the art." *In re Brandstadter* 484 F.2d 1395, at 1406-07 (CCPA 1973); MPEP, Sec. 2164.05; *Emphasis added in the MPEP* on "*merely convincing.*"

These principles have been long established within the Patent Office and the Courts. Applicant asserts that the disclosure as filed would enable the claimed invention for one skilled in the art at the time of filing. The Applicant also respectfully asserts that an Examiner should never make an enablement determination based on personal opinion. *Emphasis added in the MPEP*, Sec. 2164.05. Relative skill of one skilled in the art at the time of filing controls and all aspects need not be disclosed in specific detail or disclosed at all if it is known or would be known to one skilled in the art. MPEP, Sec. 2164.05.

Applicant respectfully asserts that environmental change and current event is sufficiently described in the specification and the claims in manners that would have enabled one of skill in the art to make and practice the invention. This is so, because environmental change and current event are not being used in a context different from their ordinary meanings and, thus a statistician would recognize this and recognize that campaign correlations that are continuously being processed at intervals would at some point in time reflect changes in the environment or in current events. These concepts are well understood by statisticians and there is no additional explanation needed. Moreover, the Examiner has not provided the Applicant with any explanation as to why specific definitions would be needed by one skilled in the art.

Thus, Applicant believes that the Sec. 112 rejections cannot be sustained in view of existing Patent Office practice guidelines enumerated in the MPEP and in view of long established legal precedent issued from the Federal Courts. Therefore, Applicant submits these rejections have been overcome and should be withdrawn. If the Examiner elects to maintain them, then Applicant asserts a subsequent Final Office Action is not appropriate because the Examiner has not indicated why the Examiner believes these specific definitions are necessary.

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The Examiner has simply concluded that the more specific definitions are necessary without any rationale for why a statistician would find them necessary to practice the invention and without any indication as to what degree the "more specific" should be.

For all these reasons the Sec. 112 rejections should be withdrawn.

§*103 Rejection of the Claims*

Claims 1-20 were rejected under 35 USC § 103(a) as being anticipated by Thearling (U.S. 6,240,411) in view of the SAS software product featured on the website www.sas.com. It is fundamental that in order to sustain an obviousness rejection that each and every step or element in the rejected claims must be taught or suggested in the proposed combination of references. The remarks provided herein relate to the amended independent claim language presented above for independent claims 1, 8, and 15.

Initially, Applicant would like to incorporate by reference the previous arguments with respect to Thearling. To highlight those points, Applicant assert that time is an incidental factor in Thearling related to elapsed time of a calculation and not to environmental changes. It appears that the Examiner has agreed with this assessment because the Sec. 102 rejections have been withdrawn in this action. In support of this missing time aspect, which is not present in Thearling, the Examiner has combined the Thearling reference with the newly cited SAS reference.

First, Applicant does not agree and cannot ascertain whether the SAS reference cited by the Examiner has a publication date prior to June 27, 2000, which is the file date of Applicant's invention. Even assuming the article existed prior to Applicant's file date, there is no indication that it was publicly available and properly indexed and accessible from the Internet. Thus, Applicant reserves the right to object to this reference at some later point in time and does not admit that the reference predates the Applicant's file date. However, for purposes of expediting the application, the Applicant will argue the SAS reference herein and below.

SAS permits the interpolation of data on monthly, weekly, or quarterly time periods. SAS also incorporates external data, such as economic data in its calculations. There is no teaching and no suggestion of a teaching in the SAS reference that a success of an on-going

campaign can be used to dynamically modify or alter intervals of the campaign, as is now positively recited in Applicant's amended independent claims 1, 8, and 15.

In the Final Office Action, the Examiner appears to assert that adjusting intervals is a feature taught in Thearling. Specifically, with respect to claim 4, the Examiner recites a reference in Thearling at col. 8 lines 38-42. Applicant has studied this reference and respectfully disagrees with the Examiner's conclusion that this passage teaches dynamically modifying intervals. The passage is used to demonstrate that selection criteria can be defined in a modified or customized manner, such as a query to the data store. The passage does not teach or even hint at a teaching that the interval during which the query is made to the data store can be dynamically adjusted during a campaign. The passage relates to defining criteria it does not relate to defining a modifiable interval during which the criteria is obtained. Applicant respectfully asserts that the Thearling reference is devoid of any teaching of an interval and does not even remotely teach being able to dynamically modify an interval, since the concept of interval does not exist in Thearling. Thus, Applicant respectfully asserts the Examiner has misinterpreted the cited Thearling passage and the teachings of Thearling; such a mistake would not have been made by one skilled in the art and one reading and comprehending the teachings of Thearling would not have been able to conclude that Thearling taught dynamically modifiable campaign intervals.

Therefore, the proposed combination of SAS and Thearling fails to teach each and every aspect of Applicant's amended independent claims and the rejections should be withdrawn.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
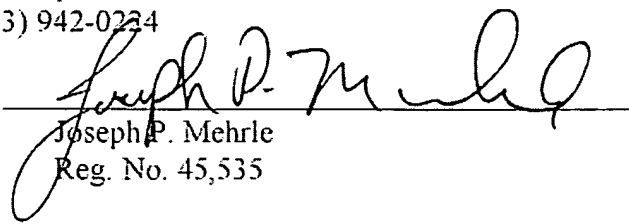
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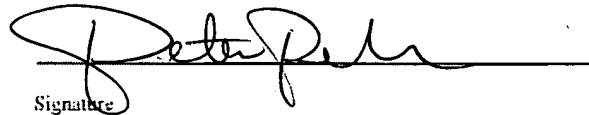Minneapolis, MN 55402
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Date ___11-30-04___   By _____
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